

REMARKS

Claims 1-16 are pending and under consideration. Reconsideration is requested based on the following remarks.

Objections to the Specification:

The Title was objected to for various informalities. The Office Action asserts at page 2 that 37 C.F.R. § 1.72 requires a title to be "descriptive and technically accurate so as to allow one of ordinary skills in the art understand the nature of the claimed invention."

37 C.F.R. § 1.72 actually provides only that: "(t)he title of the invention may not exceed 500 characters in length and must be as short and specific as possible." Since the Title did not exceed 500 characters in length, and the Title was as short and specific as possible, the title is believed to have conformed to the requirements of 37 C.F.R. § 1.72 as written. Still, in the interest of compact prosecution only, the Title of the invention is now slightly more prolix than it was originally. Withdrawal of the objection is earnestly solicited.

Information Disclosure Statement:

Certain non-patent literature (NPL) documents and Japanese language references listed on the IDS filed June 20, 2001 were crossed off as not considered because English language translations were not provided. "NIKKEI COMMUNICATIONS, No. 1995.1.2, (Japan), Kabushiki Kaisha Nikkei BP, (02.01.95), pages 64-69," and "NIKKEI Windows NT, No. 21, (Japan), Kabushiki Kaisha Nikkei BP, (12.98) Pages 34-37," however, were cited by the Japanese Patent Office in a search report during examination of International Application Serial No. PCT/JP00/00012, from which this application entered the U.S. national stage. It is submitted that is *not* necessary to submit English translations of these references attributed to Nikkei since the International Search Report constitutes a statement of relevance. A new copy of the IDS filed June 20, 2001, on which those references are indicated as having been considered, is earnestly solicited.

Furthermore, JP 9-161150 ought to have been considered since the Japanese Patent Office cited it in the above-mentioned search report during examination of International Application Serial No. PCT/JP00/00012 as well. JP 9-161150, in any case, corresponds to US 5,903,875, while JP 9-503322 corresponds to WO95/08231, and thus the references have already been considered. Furthermore, since JP 9-503322 corresponds to WO95/08231 and JP 9-161150 corresponds to US 5,903,875, WO95/08231 and US 5,903,875 constitute English

language translations of those references. A new copy of the IDS filed June 20, 2001, on which those references are indicated as having been considered, is earnestly solicited.

Finally, the English language Abstract accompanying JP 10-105626 ought to have fulfilled the requirements for a concise statement of relevance under 37 C.F.R. § 1.98 for that document as well, and it, too, should have been considered. A new copy of the IDS filed June 20, 2001, on which that reference is indicated as having been considered, is earnestly solicited.

Objections to the Claims:

Claims 1-16 were objected to for an informality. The Office Action intends to treat the recitation "information-processing product" as meaning client software. The definition of information processing products is broader than simply client software, including, inter alia personal computers, portable telephones, PDAs, hardware products such as set-top boxes, software, and software products such as recording media storing software as well, as described in the specification at page 1, lines 13-18. The coverage of claims 1-16 is therefore submitted to have been interpreted unnecessarily narrowly, and ought to be reconsidered. Withdrawal of the objection is earnestly solicited.

Claim Rejections - 35 U.S.C. § 101:

Claim 3 was rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter. The rejection is traversed.

The Office Action asserts at page 5 that,

"In fact, the process or steps disclosed in independent claim 3 pertains to a manual process and therefore, the claim does not fall within the technological art."

In a precedential opinion of the Board of Patent Appeals and Interferences, Ex parte Lundgren, Appeal No. 2003-2088 (BPAI 2005), however, the Board dispensed with the so-called "technological arts" test, saying,

"Our determination is that there is currently no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101. We decline to create one. Therefore, it is apparent that the examiner's rejection cannot be sustained."

Since there currently is no judicially recognized separate 'technological arts' test to determine patent eligible subject matter under § 101, claim 3 is submitted to be directed to statutory subject matter within the provisions of 35 U.S.C. § 101.

Lundgren, furthermore, is a precedential opinion, and is thus binding, unlike Ex parte Bowman, which was cited in the Office Action at page 5.

Furthermore, 35 U.S.C. § 101 provides,

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Furthermore, as provided in State Street Bank and Trust Co. v. Signature Financial Group Inc., 149 F. 3d 1368, 1375 (Fed.Circ. 1998),

Today, we hold that the transformation of data, representing discrete dollar amounts, by a machine through a series of mathematical calculations into a final share price, constitutes a practical application of a mathematical algorithm, formula, or calculation, because it produces "a useful, concrete and tangible result"-a final share price momentarily fixed for recording and reporting purposes and even accepted and relied upon by regulatory authorities and in subsequent trades.

Since claim 3 recites, inter alia "A payback method for making payback to a product user or a middleman when a service is received by using a product distributed by a product manufacturer or the middleman," claim 3 does produce a useful, concrete, tangible result. Claim 3 is thus submitted to be directed to statutory subject matter within the provisions of 35 U.S.C. § 101.

Furthermore, as provided in State Street,

The plain and unambiguous meaning of § 101 is that any invention falling within one of the four stated categories of statutory subject matter may be patented, provided it meets the other requirements for patentability set forth in Title 35, i.e., those found in §§ 102, 103, and 112, ¶2.

Since claim 3 does fall within one of the four stated categories of statutory subject matter, i.e. a process, claim 3 is submitted to be directed to statutory subject matter within the provisions of 35 U.S.C. § 101.

Furthermore, as provided in State Street,

The repetitive use of the expansive term "any" in § 101 shows Congress's intent not to place any restrictions on the subject matter for which a patent may be obtained beyond those specifically recited in § 101. Indeed, the Supreme Court has acknowledged that Congress intended § 101 to extend to "anything under the sun that is made by man." Diamond v. Chakrabarty, 447 U.S. 303, 309 (1980); see also Diamond v. Diehr, 450 U.S. 175, 182 (1981).

Since Congress intended § 101 to extend to "anything under the sun that is made by

man", claim 3 must be directed to statutory subject matter within the provisions of 35 U.S.C. § 101.

Finally, as provided in State Street,

Thus, it is improper to read limitations into § 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations. See Chakrabarty, 447 U.S. at 308 ("We have also cautioned that courts 'should not read into the patent laws limitations and conditions which the legislature has not expressed.'" (citations omitted)).

Since it is improper to read limitations into § 101 on the subject matter that may be patented where the legislative history indicates that Congress clearly did not intend such limitations, the further requirements listed at page 6 of the Office Action, i.e. "the steps or process of storing use results . . . and calculating a payback value . . . , as recited in the claims, should be implemented via a device, such as a computer system, a database, a data communication, computer network, the Internet, and so and so forth," are unlawful and ought to be withdrawn. Claim 3 is thus submitted to be directed to statutory subject matter within the provisions of 35 U.S.C. § 101. Withdrawal of the rejection of claim 3 is earnestly solicited.

Claim Rejections - 35 U.S.C. § 103:

Claims 1-16 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brewer et al. US 6,148,332 (hereinafter "Brewer"). The rejection is traversed. Reconsideration is earnestly solicited.

Claim 1 recites,

"calculating a payback value or payback values to one or both of the product user and the middleman based on said storage means."

Brewer neither teaches, discloses, nor suggests "calculation means for calculating a payback value or payback values to one or both of the product user and the middleman based on said storage means," as recited in claim 1. As Brewer, rather, describes in the Abstract, "A client software component for a personal computer (PC) interacts with a server of an Internet Service Provider (ISP) to require messages, such as advertisements, to be displayed in a particular manner on a display screen of the PC for interaction with a user and reporting user activity." Why would Brewer bother with offering incentives like payback values when the ISP can require messages, such as advertisements, to be displayed? It's not like the client software component has any choice in the matter anyway.

As Brewer describes further in the Abstract, "As long as a valid communication

connection between the PC and the ISP exists, the PC is forced to display a particular message in a particular fashion.” Since the PC is forced to display a particular message in a particular fashion, why waste money offering, let alone calculating a value of, a payback?

Finally, as Brewer describes in the Abstract, “A user will not be allowed to minimize the message, close the message, or hide the message behind other windows on the PC display screen.” Since the user will not be allowed to minimize the message, close the message, or hide the message behind other windows on the PC display screen, what difference would a payback make? Brewer, in fact, mentions no payback at all, let alone calculation of a payback value. Neither does the Office Action assert that Brewer describes calculating a payback value.

Furthermore, nowhere does the Office Action assert that anywhere in the so-called “public disclosure” is a calculation of a payback value disclosed, either. Although the Office Action alludes to the possibility of offering financial incentives to a distributor at, e.g. page 10, the value of the incentive could not be calculated. Who knows what the distributor does with the disk? He could throw them away, or use them as drink coasters, and claim they were “distributed” in order to collect the financial incentives. Thus, even if the entire soliloquy at pages 10 and 11 of the Office Action were taken at face value, the claimed invention would not result.

Finally, the Office Action provides no motivation or suggestion to modify the teachings of Brewer, as required by 35 U.S.C. § 103(a) and the M.P.E.P. §706.02(j)(D), to arrive at the claimed invention. The motivation cited in the Office Action at page 11, rather, “to measure the effectiveness of the distribution of the diskettes or CDs through third parties or independent distributors and the ISP is able to increase its subscriber base and business bottom line while compensations or money received by the distributor for giving away the recordable media, having the ISP client- software encoded thereon, to his customers are used to help cover overhead expenses,” amounts only to distributing software for free, not calculating a payback value.

Brewer, rather, is directed to an ISP, as described in the Abstract. The software has done been distributed. Furthermore, Brewer has given up on offering incentives to use software, as described in the Abstract. Brewer, rather, is about forcing users to display messages. There is no need in Brewer, let alone any motivation, to pay a user to monitor whether the user is displaying the message. Claim 1 is submitted to be allowable. Withdrawal of the rejection of claim 1 is earnestly solicited.

Claim 2 depends from claim 1 and adds additional distinguishing elements. Claim 2 is

thus also submitted to be allowable. Withdrawal of the rejection of claim 2 is earnestly solicited.

Claim 3:

Claim 3 recites,

"calculating a payback value or payback values to one or both of the product user and the middleman."

Brewer neither teaches, discloses, nor suggests "calculating a payback value or payback values to one or both of the product user and the middleman," as discussed above with respect to the rejection of claim 1.

Claim 3 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 3 is earnestly solicited.

Claims 4 and 5:

Claim 4 recites,

"determining a payback value or payback values of the product to one or both of the customer and the middleman."

Brewer neither teaches, discloses, nor suggests "determining a payback value or payback values of the product to one or both of the customer and the middleman," as discussed above with respect to the rejection of claim 1.

Claim 4 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 4 is earnestly solicited.

Claim 5 depends from claim 4 and adds additional distinguishing elements. Claim 5 is thus also submitted to be allowable. Withdrawal of the rejection of claim 5 is earnestly solicited.

Claims 6, 7, and 8:

Claim 6 recites,

"calculating a payback value to be paid to the distributor by the network service provider."

Brewer neither teaches, discloses, nor suggests "calculating a payback value to be paid to the distributor by the network service provider," as discussed above with respect to the rejection of claim 1.

Claim 6 is submitted to be allowable, for at least those reasons discussed above with

respect to the rejection of claim 1. Withdrawal of the rejection of claim 6 is earnestly solicited.

Claims 7 and 8 depend from claim 6 and add additional distinguishing elements. Claims 7 and 8 are thus also submitted to be allowable. Withdrawal of the rejection of claims 7 and 8 is earnestly solicited.

Claim 9:

Claim 9 recites,

"calculating a payback value to be paid to the distributor by the network service provider."

Brewer neither teaches, discloses, nor suggests "calculating a payback value to be paid to the distributor by the network service provider," as discussed above with respect to the rejection of claim 1.

Claim 9 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 9 is earnestly solicited.

Claims 10 and 11:

Claim 10 recites,

"calculating a payback value or payback values to one or both of the product user and the middleman."

Brewer neither teaches, discloses, nor suggests "calculating a payback value or payback values to one or both of the product user and the middleman," as discussed above with respect to the rejection of claim 1.

Claim 10 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 10 is earnestly solicited.

Claim 11 depends from claim 10 and adds additional distinguishing elements. Claim 11 is thus also submitted to be allowable. Withdrawal of the rejection of claim 11 is earnestly solicited.

Claims 12 and 13:

Claim 13 recites,

"determining a payback value or payback values of the product to one or both of the customer and the middleman."

Brewer neither teaches, discloses, nor suggests “determining a payback value or payback values of the product to one or both of the customer and the middleman,” as discussed above with respect to the rejection of claim 1.

Claim 12 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 12 is earnestly solicited.

Claim 13 depends from claim 12 and adds additional distinguishing elements. Claim 13 is thus also submitted to be allowable. Withdrawal of the rejection of claim 13 is earnestly solicited.

Claims 14, 15, and 16:

Claim 14 recites,

"calculating a payback value to be paid to the distributor by the network service provider

Brewer neither teaches, discloses, nor suggests “calculating a payback value to be paid to the distributor by the network service provider,” as discussed above with respect to the rejection of claim 1.

Claim 14 is submitted to be allowable, for at least those reasons discussed above with respect to the rejection of claim 1. Withdrawal of the rejection of claim 14 is earnestly solicited.

Claims 15 and 16 depend from claim 14 and add additional distinguishing elements. Claims 15 and 16 are thus also submitted to be allowable. Withdrawal of the rejection of claims 15 and 16 is earnestly solicited.

Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 1-16 are allowable over the cited references. There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

Serial No. 09/883,913

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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PRECEDENTIAL OPINION

Pursuant to the Board of Patent Appeals and Interference's Standard Operating Procedure 2,
the opinion below has been designated a precedential opinion.

Paper No. 78

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte CARL A. LUNDGREN

Appeal No. 2003-2088
Application 08/093,516

HEARD: April 20, 2004

Before FLEMING, Chief Administrative Patent Judge, HARKCOM, Vice Chief
Administrative Patent Judge, and HAIRSTON, JERRY SMITH, and BARRETT,
Administrative Patent Judges.

PER CURIAM.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the rejection of claims 1, 2, 6, 7,
19-22, 32, and 35-40, all the claims pending in the application.

Claim 1 is representative of the subject matter on appeal and reads as follows:

1. A method of compensating a manager who exercises administrative control over operations of a privately owned primary firm for the purpose of reducing the degree to which prices exceed marginal costs in an industry, reducing incentives for industry collusion between the primary firm and a set of comparison firms in said industry, or reducing incentives for coordinated special interest industry lobbying, said

set of comparison firms including at least one firm, said primary firm having the manager who exercises administrative control over said primary firm's operations during a sampling period, wherein privately owned means not wholly government owned, the method comprising the steps of:

- a) choosing an absolute performance standard from a set of absolute performance standards;
- b) measuring an absolute performance of said primary firm with respect to said chosen absolute performance standard for said sampling period;
- c) measuring an absolute performance of each firm of said set of comparison firms with respect to said chosen absolute performance standard for said sampling period, said measurement of performance for each firm of said set of comparison firms forming a set of comparison firm absolute performance measures;
- d) determining a performance comparison base based on said set of comparison firm absolute performance measures by calculating a weighted average of said set of comparison firm absolute performance measures;
- e) comparing said measurement of absolute performance of said primary firm with said performance comparison base;
- f) determining a relative performance measure for said primary firm based on said comparison of said primary firm measurement of absolute performance and said performance comparison base;
- g) determining the managerial compensation amount derived from said relative performance measure according to a monotonic managerial compensation amount transformation; and
- h) transferring compensation to said manager, said transferred compensation having a value related to said managerial compensation amount.

This is the second time this case has been appealed to the Board. In Appeal No. 96-0519, a merits panel reversed the examiner's rejection premised upon 35 U.S.C. § 101 (non-statutory subject matter) of the claims then pending. The panel stated "[w]e find that the claim language recites subject matter that is a practical application of shifting of physical assets to the manager. We note the remaining claims also recite

the above practical application. Therefore, we find statutory subject matter." Paper No. 49, page 7.

Dissatisfied with the outcome of the previous appeal, the Examining Corps filed a "Request for Reconsideration and Rehearing" (Paper No. 50, December 15, 1999) that lists two issues for reconsideration as follows:

1. Whether the invention as a whole is in the technological arts.
2. Assuming that the invention is in the technological arts, whether the claim transferring compensation to a manager is a practical application.

Id., page 2.

Appellant filed a response to the Request for Reconsideration and Rehearing (Paper No. 51, January 13, 2000).

In an opinion (Paper No. 52) mailed March 13, 2001, an expanded panel of the Board remanded the application to the examiner for two reasons. First, the record did not reflect that the examiner had considered and evaluated appellant's response to the Request for Reconsideration and Rehearing, and second, the Office of the Deputy Commissioner for Patent Examination Policy had requested that the application be remanded to the jurisdiction of the patent examiner so that issues regarding "technological arts" and "practical application" could be further considered.

Following further prosecution before the examiner in which the examiner maintained a rejection under 35 U.S.C. § 101 (non-statutory subject matter), appellant filed a second appeal to this Board (Paper No. 64, December 12, 2002), followed by his Appeal Brief (Paper No. 69, March 13, 2003). The examiner filed an Answer on May 1, 2003 (Paper No. 70), that was followed by a Reply Brief (Paper No. 72, June 20, 2003).

Oral argument was held by an expanded panel on April 20, 2004, and the case was taken under advisement.

DISCUSSION

We reverse the examiner's rejection under 35 U.S.C. § 101 (non-statutory subject matter). In reviewing the Examiner's Answer, we find the examiner refers the reader to Paper No. 60 for a statement of the rejection under § 101. We have reviewed Paper No. 60 and find that a rejection under this section of the statute is set forth on pages 4-8 thereof. The examiner states "both the invention and the practical application to which it is directed to be outside the technological arts, namely an economic theory expressed as a mathematical algorithm without the disclosure or suggestion of computer, automated means, apparatus of any kind, the invention as claimed is found non-statutory." Paper No. 60, page 7.

In reviewing the examiner's "Response to Argument" set forth at pages 3-8 of the Examiner's Answer of May 1, 2003, we first note that the examiner states that "the part of the 35 U.S.C. § 101 rejection that asserted that claims 1, 2, 6, 7, 19-22, 32, and 35-40 fail to produce a useful, concrete, and tangible result is withdrawn."¹ By withdrawing this rejection, it can be concluded that the examiner has found that the process claims on appeal produce a useful, concrete, and tangible result.

Since the Federal Circuit has held that a process claim that applies a mathematical algorithm to "produce a useful, concrete, tangible result without pre -

¹ The examiner had instituted two separate rejections under Section 101 in Paper No. 60. The first was on the basis that the claims were "nothing more than an abstract idea which is not associated or connected to any technological art," *id.*, pages 4-7, and second was that the claims did not "achieve a practical result," *id.*, pages 7-8.

emptying other uses of the mathematical principle, on its face comfortably falls within the scope of § 101," AT&T Corp. v. Excel Communications, Inc., 172 F.3d 1352, 1358, 50 USPQ2d 1447, 1452 (Fed. Cir. 1999), one would think there would be no more issues to be resolved under 35 U.S.C. § 101. However, the examiner is of the opinion that there is a separate test for determining whether claims are directed to statutory subject matter, i.e., a "technological arts" test.

Thus, the only issue for review in this appeal is, to use the examiner's terminology, "whether or not claims 1, 2, 6, 7, 19-22, 32, and 35-40 are limited to the technological arts, as required by 35 U.S.C. § 101." Examiner's Answer, page 3.

35 U.S.C. § 101 provides:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

As seen, claim 1 on appeal is directed to a process. Thus, one may wonder why there is any issue regarding whether claim 1 is directed to statutory subject matter. The issue arises because the Supreme Court has "... recognized limits to § 101 and every discovery is not embraced within the statutory terms. Excluded from such patent protection are laws of nature, physical phenomena and abstract ideas." Diamond v. Diehr, 450 U.S. 175, 185, 209 USPQ 1, 7 (1981). However, in this appeal, the examiner has not taken the position that claim 1 is directed to a law of nature, physical phenomena or an abstract idea, the judicially recognized exceptions to date to § 101. Rather, the examiner has found a separate "technological arts" test in the law and has determined that claim 1 does not meet this separate test.

The examiner finds the separate "technological arts" test in In re Musgrave, 431 F.2d 882, 167 USPQ 280 (CCPA 1970); In re Toma, 575 F.2d 872, 197 USPQ 852 (CCPA 1978); and Ex parte Bowman, 61 USPQ2d 1669 (Bd. Pat. App. & Int. 2001)(non-precedential). We have reviewed these three cases and do not find that they support the examiner's separate "technological arts" test.

In Musgrave, the court reversed a rejection under 35 U.S.C. § 101 that the claims under review therein were non-statutory because it disagreed with the Board that "these claims . . . are directed to non-statutory processes merely because some or all of the steps therein can also be carried out in or with the aid of the human mind or because it may be necessary for one performing the processes to think." Musgrave 431 F.2d at 893, 167 USPQ 289. After so holding, the court went on to observe "[a]ll that is necessary, in our view, to make a sequence of operational steps a statutory 'process' within 35 U.S.C. § 101 is that it be in the technological arts so as to be in consonance with the Constitutional purpose to promote the progress of 'useful arts.' Const. Art. 1, sec. 8."

We do not view the court's statement in Musgrave in regard to the technological arts to have created a separate "technological arts" test in determining whether a process is statutory subject matter. Indeed, the court stated as much in Toma. The court first noted that the examiner in that case had "cited [inter alia, Musgrave] for the proposition that all statutory subject matter must be in the 'technological' or 'useful' arts... ." Toma, 575 F.2d at 877, 197 USPQ at 857. The court then stated that cases such as Musgrave involved what was called at that time a "mental steps" rejection and

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against the claims on appeal. We decline at this stage of the proceedings to enter a new ground of rejection based on Judge Barrett's rationale, because in our view his proposed rejection would involve development of the factual record and, thus, we take no position in regard to the proposed new ground of rejection. Accordingly, the decision of the examiner is reversed.

REVERSED

Michael R. Fleming)	
Chief Administrative Patent Judge)	
)	
)	
)	BOARD OF PATENT
Gary V. Harkcom)	APPEALS
Vice Chief Administrative Patent Judge)	AND
)	INTERFERENCES
)	
)	
Kenneth W. Hairston)	
Administrative Patent Judge)	

observed, "[t]he language which the examiner has quoted was written in answer to 'mental steps' rejections and was not intended to create a generalized definition of statutory subject matter. Moreover, it was not intended to form a basis for a new § 101 rejection as the examiner apparently suggests." Id. at 878, 197 USPQ at 857. We do not believe the court could have been any clearer in rejecting the theory the present examiner now advances in this case.

We have also considered Ex parte Bowman, cited by the examiner. Bowman is a non-precedential opinion and thus, not binding.

Finally, we note that the Supreme Court was aware of a "technological arts test," and did not adopt it when it reversed the Court of Customs and Patent Appeals in Gottschalk v. Benson, 409 U.S. 63, 175 USPQ 673 (1972). As explained in Diamond v. Diehr, 450 U.S. 175, 201, 209 USPQ 1, 14 (1981) (Stevens, J., dissenting) (footnotes omitted):

In re Benson, [441 F.2d 682, 169 USPQ 548 (CCPA 1971)] of course was reversed by this Court in Gottschalk v. Benson, 409 U.S. 63, [175 USPQ 673] (1972). Justice Douglas' opinion for a unanimous Court made no reference to the lower court's rejection of the mental-steps doctrine or to the new technological-arts standard. Rather, the Court clearly held that new mathematical procedures that can be conducted in old computers, like mental processes and abstract intellectual concepts, see id., at 67, [175 USPQ at 674-675], are not patentable processes within the meaning of § 101. (Footnotes omitted.)

Our determination is that there is currently no judicially recognized separate "technological arts" test to determine patent eligible subject matter under § 101. We decline to create one. Therefore, it is apparent that the examiner's rejection can not be sustained. Judge Barrett suggests that a new ground of rejection should be entered